



Docket No. 1293.1187

PRE-APPEAL BRIEF REQUEST FOR REVIEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jung-kwon HEO

Serial No. 09/960,504

Group Art Unit: 3621

Confirmation No. 7211

Filed: September 24, 2001

Examiner: Salvatore A Canglialosi

For: APPARATUS AND METHOD FOR TRANSCOPYING DATA

MAIL STOP AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request accompanying a Notice of Appeal requesting review of the Final Office Action mailed March 8, 2006, and having a period for response set to expire on June 8, 2006. A petition for a one month extension of time is enclosed, thereby extending the response due date to July 10, 2006 (July 8 being a Saturday). As set forth in the Advisory Action of June 21, 2006, the Amendment filed June 2, 2006 has been entered for purposes of appeal.

REQUEST FOR REVIEW OF REJECTION UNDER 35 U.S.C. §101:

On pages 2-4 of the Office Action, the Examiner again rejects claims 5, 6, and 34-42 under 35 U.S.C. §101 as being drawn to non-patentable subject matter. In rejecting the claims, the Examiner specifically asserts that the rejected claims are unpatentable "descriptive material" as opposed to functional descriptive material without accounting for the specific claim features as set forth in the claims. Since the claims recite a data structure on a medium and the interrelationship between these elements by an apparatus and these features are not accounted for in the Examiner's analysis on page 4 of the Office Action, it is respectfully requested that the rejection be withdrawn prior to the filing of an Appeal Brief.

By way of review and as set forth in the Amendment filed June 2, 2006, while the Examiner summarily states on page 4 of the Office Action that the claims are "mere arrangements of data, and thus are not statutory," the Examiner does not provide any analysis as to the reasons therefore. Specifically, this assertion is merely a restatement of the test for statutory subject matter as set forth on pages 2-4, and does further not indicate how the data as

recited in the claims is non-statutory, does not apply the various factors outlined in MPEP 2100-12 to the recited features, and does not address applicant's request for such analysis as required to substantiate a prima facie rejection under 35 U.S.C. §101 as set forth in the Amendment filed December 19, 2005.

Importantly, the Examiner's analysis does not account for the features of the claims being rejected. By way of review and example, claim 5 recites, among other features, "a rights management information area to indicate to the recording and/or reproducing apparatus whether said content data is the original content data or the copied content data transcribed from the original content data such that the recording and/or reproducing apparatus distinguishes between the original and copied content data, and to indicate to the recording and/or reproducing apparatus rights information related to the recording and/or reproducing apparatus performing data transcribing of said content data."

As previously noted in the Amendment filed June 2, 2006, even assuming arguendo that stored data file information and the rights management information area, per se, are non-functional descriptive material, it is noted that claim 5 recites more than a mere storage of data. Instead, claim 5 also recites a functional relationship between the elements, such as the elements logically connected using the rights management information area and the result of the relationship by a recording and/or reproducing apparatus reading the information from the rights management information area. Thus, the stored data file information and the rights management information area have a specific logical relationship which supports specific data manipulation functions.

Since claim 34 also recites a logical relationship between the identification information and rights information to be implemented by a computer, claims 5 and 34 recite data structures which support specific data manipulation functions so as to be distinguishable from mere listings of data. As such, claims 5 and 34 are considered functional descriptive material.

Therefore, it is respectfully submitted that the Examiner has not presented sufficient evidence to support a prima facie rejection of the claims for the purposes of 35 U.S.C. §101.

Therefore, it is requested that the Examiner withdraw the rejection of these claims under 35 U.S.C. §101.

STATUS OF CLAIMS NOT REJECTED IN OFFICE ACTION


On page 5 of the Office Action, the Examiner states that claims 1-36 and 42 are allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot.

Respectfully submitted,

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